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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,991	12/31/2001	Mark Armstrong	4P04.1-010	9632

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MEHRMAN LAW OFFICE, P.C.
ONE PREMIER PLAZA
5605 GLENRIDGE DRIVE, STE. 795
ATLANTA, GA 30342

EXAMINER

ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 05/26/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,991

Applicant(s)

ARMSTRONG ET AL.

Examiner

Greta L. Robinson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-26 are pending in the preset application.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "users" does not appear to be described properly note page 20 line 1 "if the user is a hotel"; and page 21 line 12 the "image can be a photograph, a user or a co-branding logo". Generally the term user refers to the person operating the computer system, vender or client. For, example claim 1 recites an authorized set of users, this does not appear to correspond to the referenced citations in the disclosure (i.e. hotel or image).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 18 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, 18 and 24 recites the limitation "the group" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Unold et al. Patent Application Publication No. US 2002/0055880 A1.

Regarding claim 1, **Unold et al.** teaches a database of controlled resources useable for the construction of data by an authorized set of users [note: *AD Builder Application* 1200 figure 3; "*Build AD Portfolios ...*" element 408 figure 4A; *database*

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manager application 304 figure 3; page 6 paragraph 0058; and page 10 paragraph 0078];

control logic for providing the authorized users with access to the controlled resources in accordance with a predefined implementation methodology [note: page 1 paragraph 0008; figure 5A note step 504 "AUTHORIZE ACCESS"];

rendering logic for rendering ads using the controlled resources in accordance with the control logic [note: abstract; figures 1, 3, 4A and 4B; page 8 paragraph 0066].

Unold et al. teaches a system for facilitating the sale, reservation, purchase, management, and creation of electronic advertisements. The advertisements are created using an AD Builder Application 1200 note figure 3.

9. Regarding claims 3-6, "receiving ad definitions ... submitting a request for an approval ... ad templates" [note: figure 14A, figure 4A element 410 "receive approvals"].

10. Regarding claim 7, wherein the control logic implementation methodology comprises amendment and appending [note: page 8 paragraph 0065; figure 11B and 12C].

11. Regarding claims 8-10, wherein the control logic comprises password protection ... hierarchical user access methodology [note: page 8 paragraph 0065 and 0068].

12. Regarding claim 11, wherein the control logic comprises methodology for billing the users [note: figure 4A step 414; page 10 paragraph 0075].
13. Regarding claims 12, extracting an image ... [note: page 9 paragraph 0073-0074]
14. Regarding claims 13-16, wherein each instance is customized [note: portfolio unique to advertisers page 8 paragraph 0066; also not template ability].
15. The limitations of claims 17-26 have been addressed above; therefore they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 2, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unold et al. Patent Application Publication No. US 2002/0055880 A1 in view of Speicher US patent 6,697,786 B2.

Although Unold et al. teaches the invention substantially as cited above, regarding claims 2, 18 and 24 they do not specifically teach the controlled resources are selected from the group consisting of ad templates, photos, headlines, ad body ... special offers. **Speicher** teaches an integrated ad capability that allows photographs and video clips to be integrated into the advertisement [note abstract; figure 6, 11, 14 and 16 column 15 line 60 through column 17 line 34]. It would have been obvious to one of ordinary skill at the time of the invention to have combined the cited references because it would enhance the features available for advertising.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Appleman et al. US Patent 6,226,648 B1

Landaman et al. US Patent 6,516,338 B1

Horstmann US Patent 6,285,985 B1

Witck et al. US Patent 6,253,188 B1

Landsman et al. US Patent 6,687,737 B2

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GRETA ROBINSON
PRIMARY EXAMINER

Greta Robinson
Primary Examiner
May 21, 2004